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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,572	02/08/2001	Angela Speith-Herfurth	6001-0110	5054

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,572

Applicant(s)

SPEITH-HERFURTH ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 and 20-32 of copending Application No. 09/601,790 in view of Dries et al. (5,529,843).

This is a provisional obviousness-type double patenting rejection.

The applicants claim polypropylene films comprising wax, in which claim 11 claims that the base layer can also comprise hydrocarbon resin. The copending application claims polypropylene resin, wax, and hydrocarbon resin as a mixture. The examiner relies upon Dries et al. to show that hydrocarbon resins can be added to the base layer or interlayers of polypropylene in the art of polypropylene films (column 6, lines 50+). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added resin to the polypropylene layer containing wax since hydrocarbon resin can be added to various layers in polypropylene film and there does not appear to be any criticality to the location of the material as far as internal layers go.

Claim Rejections - 35 USC § 101

3. Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 6, 8, 10, 12, 16, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 5, 6, 8, 10, 12, 16, and 19 recite a broad recitation, and the claims also recite a “preferred” embodiment, which is the narrower statement of the range/limitation. The examiner suggests that the applicants delete the preferred embodiments at the end of each of the claims and resubmit the limitations as dependant claims.

7. Claim 19 provides for the use of the film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-5, 7-9, 10, 12, 13, 16, 17, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chu et al. (6,159,612).

10. Chu et al. teach 5 layer films (A/B/C/B/A) having intermediate layers comprising a blend of polypropylene and wax. The wax materials have molecular weights between 300 and 800, preferably 300 to 450 (column 2, lines 45-55). The examples show that layers (B) have thickness of about 4.3 microns, and a wax concentration of at least 10%, in which the example shows amounts of 15%.

The claimed molecular weights of the waxes are relatively low. The examiner takes the position that the molecular weight distribution of the materials taught by Chu et al. would be low. As molecular weights go down, it is easier to measure them in an accurate manner so there would be smaller differences in the results obtained from different methods: ergo, low molecular weight distribution.

The applicants state that the surface layers of their film are heat-sealable, while Chu et al. is silent regarding the sealability of the surface layers, they are made from olefin polymers similar to the ones cited by the applicants in their specification so there is reason to believe that they would be sealable as claimed (column 3, lines 28-42).

The films are coated with a coating comprising finely divided inorganic materials, so it would have a matte finish as claimed.

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* The applicants claim (claim 10), that the base layer has an isotactic polypropylene having an isotactic index of at least 95%. The higher the melting point of a polypropylene material the more crystalline it is and the isotactic index is directly related to the crystallinity of the resin. Since Chu et al. use highly isotactic materials having low heptane extractables and high melting points (above 150 deg), there is reason to believe that they use the types of materials claimed (column 2, lines 1+).

Chu et al. use standard additives (column 4), which correspond to what the applicants use.

Regarding claim 18, the films are stretched 4.5 to 6 times in the machine direction and 6-13 times in the transverse direction (column 6, lines 4-12). Finally films of this type are used in packaging applications as claimed.

11. Claims 1-10, 12, and 14-19 rejected under 35 U.S.C. 102(b) as being anticipated by Heffelfinger (6,033,771).

The disclosure of Heffelfinger parallels that of Chu et al. (both are Mobil Patents) except in this instance the five-layer structure comprises intermediate voided layers of isotactic polypropylene and wax.

12. Claims 1-10, 12-19 rejected under 35 U.S.C. 102(e) as being anticipated by Su et al. (6,312,825)

This rejection is provisional, and can be over come by a translation of the priority document.

* The disclosure of Su et al. parallels that of Chu et al. (both are Mobil Patents) except in this instance the five-layer structure comprises a core layer of isotactic polypropylene and wax. The films may be voided or non-voided so can be transparent or opaque as claimed.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heffelfinger (6,033,771) or Chu et al (6,159,612) in view of Bothe et al. (5,254,394).

Heffelfinger or Chu et al. as discussed above teaches the applicants' basic structure but they are silent regarding the isotacticity of the isotactic polypropylene and neither teaches the addition of hydrocarbon resins as claimed.

Bothe et al. teach that polypropylene having an isotacticity of greater than 95% and melting points of greater than 140 deg C, preferably greater than 150 deg C (claims 2 and 22, and column 2, lines 24-42) are used in the production of films. The examiner maintains that the isotactic polypropylene materials used by Chu et al. and Heffelfinger are the same as those claimed, or it would have been obvious to use the isotactic polypropylene materials having isotactic indexes above 95% described in Bothe et al. since they have the high melting points required by the primary references.

Bothe et al. show that hydrocarbon resins are added to the inner or surface layer of packaging films (column 4, lines 6+) to improve the properties of the films.

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• It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added conventional additives such as those discussed in Bothe et al. for their known and expected function, including the addition of hydrocarbon resins, in order to improve the properties of the films taught by Heffelfinger or Chu et al

Conclusion

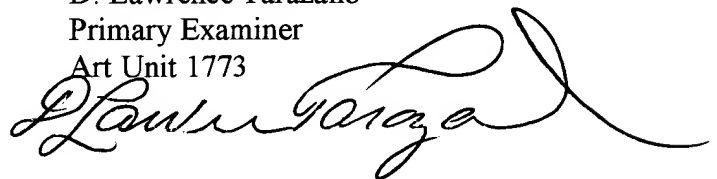
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner cites Peet (6,270,912) as being of interest, see claim 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773



dlt
September 20, 2002